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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,610	06/20/2001	Takashi Ishitani	70820-56140	5340

21874 7590 06/15/2005

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EXAMINER

SHINGLES, KRISTIE D

ART UNIT PAPER NUMBER

2141

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,610

Applicant(s)

ISHITANI, TAKASHI

Examiner

Kristie Shingles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Applicant has amended claims 12, 31, 36 and 41-43. Claims 51 and 52 have been added. Claims 1-52 are pending.

Response to Arguments

1. Applicant's arguments with respect to claims 1, 12, 22, 31, 35, 36, 40, 41 and 43 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims **1, 2 and 22** are rejected under 35 U.S.C. 102(e) as being anticipated by *Rudy et al* (USPN 6,360,252).

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a. **Per claim 1, *Rudy et al*** teach an electronic mail transmission/reception system for communicating data between an electronic mail creating/sending device and an electronic mail receiving/reproducing device via a network, wherein: said electronic mail creating/sending device comprises:

- an electronic mail creating means creating multimedia data including attached data representing an image, voice/sound, or the like (Abstract and col.7 lines 14-22; attachments may take the form of text, images, audio etc.); and
- an ID generating means generating an ID corresponding to the attached data such that said electronic mail creating/sending device sends the generated ID instead of the attached data (Abstract, col.2 lines 2-10 and Fig.1; system generates a user-understandable descriptor that is emailed to the user instead of the attachment), and
- said electronic mail receiving/reproducing device comprises: a real data generating means generating real data representing an image, voice/sound or the like corresponding to the ID such that said electronic mail receiving/reproducing device reproduces the image, voice/sound or the like represented by the real data (Abstract, col.2 lines 2-10 and col.3 line 30-col.4 line 61; client device serves as the reproducing device, producing a rendered version of the attachment).

b. **Claim 22** contains limitations that are substantially equivalent to claim 1 and is therefore rejected under the same basis.

c. **Per claim 2, *Rudy et al*** teach the electronic mail transmission/reception system of claim 1, wherein the ID generating means generates an ID based on a category of attached data (Abstract; descriptor can be based on selected categories of rendering options).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **3-21, 23-34, 36-39 and 41-52** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Rudy et al* (USPN 6,360,252) in view of *Guck* (USPN 5,794,039).

a. **Per claim 41**, *Rudy et al* teach an electronic mail transmission/reception device for sending and receiving mail data via a network, comprising: an electronic mail creating/sending device including an electronic mail creating means creating multimedia data including attached data representing an image, voice/sound, or the like (Abstract; attachments may take the form of text, images, audio etc.); and an ID generating means generating an ID corresponding to the attached data such that the electronic mail creating/sending device sends the generated ID instead of the attached data (Abstract, col.2 lines 2-10 and Fig.1; system generates a user-understandable descriptor that is emailed to the user instead of the attachment), and an electronic mail receiving/reproducing device receiving and reproducing multimedia data including an ID corresponding to attached data representing an image, voice/sound, or the like, comprising: a real data generating means generating real data representing an image, voice/sound or the like corresponding to an ID included in the multimedia data such that the electronic mail receiving/reproducing device reproduces the image, voice/sound or the like represented by the real data (Abstract, col.2 lines 2-10 and col.3 line 30-col.4 line 61; client device serves as the reproducing device, producing a rendered version of the attachment).

Yet *Rudy et al* fail to explicitly teach referencing an ID table that represents correspondence between data and IDs. However, *Guck* discloses attachments stored in a database

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for accessing and referencing with associated article numbers (col.3 lines 6-32, col.5 line 65-col.6 line 15, col.11 line 30-col.13 line 11 and col.14 lines 19-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Rudy et al* and *Guck* for the purpose of maintaining a relational database or data structure for the attachments and their respective identifiers; because it would provision efficient access, maintenance and archival of the message attachments.

b. **Claims 12, 31 and 36** contain limitations that are substantially equivalent to claim 41 and are therefore rejected under the same basis.

c. **Per claim 43**, *Rudy et al* teach an Internet access device comprising: a real data generating means for generating real data representing image, voice/sound or the like corresponding to an ID representing attached data representing image, voice/sound or the like included in multimedia data (Abstract; server generates real data representing the attached data in formats including text, image, audio, etc); a real data acquiring means for acquiring real data corresponding to the ID from a specific server or a server designated by a URL when the real data generating means cannot generate the real data corresponding to the ID (col.11 lines 38-60; server can be accessed via URL for real data acquisition); and a reproducing means for reproducing the real data (Abstract, col.2 lines 2-10 and col.3 line 30-col.4 line 61; real data is reproduced for the client/user on the rendering device).

Yet *Rudy et al* fail to explicitly teach referencing an ID table that represents correspondence between data and IDs. However, *Guck* discloses attachments stored in a database

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for accessing and referencing with associated article numbers (col.3 lines 6-32, col.5 line 65-col.6 line 15, col.11 line 30-col.13 line 11 and col.14 lines 19-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Rudy et al* and *Guck* for the purpose of maintaining a relational database or data structure for the attachments and their respective identifiers; because it would provision efficient access, maintenance and archival of the message attachments.

d. **Per claim 13**, *Rudy et al* teach the electronic mail transmission/reception system of claim 12, wherein the server connected to the network comprises a real data generating means generating real data representing an image, voice/sound or the like corresponding to the ID such that the server sends the real data instead of the ID to said electronic mail receiving/reproducing device (Abstract; server generates the user-understandable descriptor that corresponds to the email attachment and sends the descriptor instead of the attachment).

e. **Claim 3** is substantially similar to claim 13 and is therefore rejected under the same basis.

f. **Per claim 14**, *Rudy et al* teach the electronic mail transmission/reception system of claim 12, wherein the real data is identical to the attached data (col.3 line 10-col.4 line 18, col.24 lines 7-18 and col.25 lines 24-36; the real data can be the attached data or a reformatted version of the attached data capable of being displayed on the rendering device).

g. **Claims 4, 5, 15, 23, 24, 32, 37 and 38** are substantially similar to claim 14 and are therefore rejected under the same basis.

h. **Per claim 16, *Rudy et al*** teach the electronic mail transmission/reception system of claim 13, wherein the e-mail creating/sending device further comprises an ID acquiring means which, when its own ID generating means fails to generate an ID corresponding to attached data, inquires of the server about an ID corresponding to the attached data to acquire the ID corresponding to the attached data from the server such that the e-mail creating/sending device sends the ID acquired from the server instead of the attached data (Abstract; client machine may request the descriptor as a selectable item, thus the selectable item is sent from the server to the client instead of the attachment).

i. **Claims 6, 25 and 33** are substantially similar to claim 16 and are therefore rejected under the same basis.

j. **Per claim 17, *Rudy et al*** teach the electronic mail transmission/reception system of claim 13, wherein the e-mail creating/sending device has a data/ID acquiring means which, when there is a request for attached data other than attached data corresponding to an ID which can be generated by the ID generating means of the e-mail creating/sending device, acquires such attached data and the ID corresponding to the attached data from the server (Abstract and col.8 lines 49-67; client can request attached data from server and receive the output version of the data for display on the rendering device).

k. **Claims 7, 26, 34 and 52** are substantially similar to claim 17 and are therefore rejected under the same basis.

l. **Per claim 18, *Rudy et al*** teach the electronic mail transmission/reception system of claim 12, wherein the e-mail receiving/reproducing device has a real data acquiring means which, when the real data generating means of the e-mail receiving/reproducing device fails to

generate real data corresponding to an ID, inquires of the server about real data corresponding to the ID to acquire the real data corresponding to the ID from the server such that the e-mail receiving/reproducing device reproduces the real data acquired from the server (col.7 line 66-col.8 line 67; client can inquire/request attached data from server and receive the output version of the real data that corresponds to the client version—which only includes the descriptor—for display on the rendering device).

m. **Claims 8, 27 and 39** are substantially similar to claim 18 and are therefore rejected under the same basis.

n. **Per claim 19, *Rudy et al*** teach the electronic mail transmission/reception system of claim 12, wherein the server sends the attached data, the ID, or another ID belonging to the same category as the ID to the e-mail receiving/reproducing device depending on ability of the e-mail receiving/reproducing device or at a request thereof (col.3 line 53-col.4 line 48; the server sends the attachment or descriptor of the email depending on the capabilities of the user's rendering device).

o. **Claims 9 and 28** are substantially similar to claim 19 and are therefore rejected under the same basis.

p. **Per claim 20, *Rudy et al*** teach the electronic mail transmission/reception system of claim 12, wherein the ID is part of HTML e-mail, and the ID can be identified by tags enclosing the ID at its front and back (col.7 line 23-col.8 line 6, col.21 line 14-39 and col.26 lines 54-58; descriptors identify the attached data and can appear in various formats in the client version email, depending on the content of the attachment).

q. **Claims 10, 11, 21, 29 and 30** are substantially similar to claim 20 and are therefore rejected under the same basis.

r. **Per claim 42**, *Rudy et al* teach the electronic mail transmission/reception device of claim 41, comprising: a recognizing means which, upon receiving multimedia data including an ID and attached data corresponding to the ID in a prescribed format, recognizes the ID and the attached data while associating them with each other, said ID generating means being able to generate the ID associated with the attached data recognized by the recognizing means (col.8 line 7-67; the client machine is able to recognize and make the appropriate association with the multimedia attachment descriptor client version email and the output version email for the rendering device).

s. **Per claim 44**, *Rudy et al* teach the recording medium containing a program for making computers function as the electronic mail creating means, the ID generating means and the real data generating means of the electronic mail transmission/reception system of claim 1 (col.7 line 60-col.8 line 48, col.9 lines 11-67, col.26 lines 10-67 and col.27 line 15-col.29 line 8; system comprises client machines and servers with storage mediums and program code for creating and transmitting emails, for generating descriptors of the real data and acquiring real data).

t. **Claims 45 – 50** are substantially similar to claim 44 and are therefore rejected under the same basis.

u. **Per claim 51**, *Guck* teaches the electronic mail transmission/reception system of claim 1, wherein the ID generating means generates the ID corresponding to the attached data by

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referencing an ID table that represents correspondence between data and IDs (col.3 lines 6-32, col.5 line 65-col.6 line 15, col.11 line 30-col.13 line 11 and col.14 lines 19-36).

6. Claims **35 and 40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudy et al (USPN 6,360,252) and *Guck* (USPN 5,794,039) in view of *Luzeski et al* (USPN 6,404,762).

a. **Per claim 35**, *Rudy et al* teach the device of claim 31 as applied above, yet fail to distinctly teach the electronic mail creating/sending device of claim 31, further comprising an ID registering means storing IDs and attached data corresponding to the IDs in categorized manner, and for a new attached data, identifying a category of the data, allocating an ID to the data and registering the data and the ID. However, *Luzeski et al* teach the use of multimedia containers and storage mediums for storing and cataloging attachment identifiers and attached data (col.16 line 50-col.18 line 38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Rudy et al*, *Guck* and *Luzeski et al* to store and catalogue attached data and corresponding identifiers for attached data for the purpose of maintaining a current collection of the attached data and IDs useful in archiving for future access or queries. One skilled in the art would have been motivated to generate the claimed invention with a reasonable expectation of success.

b. **Per claim 40**, *Rudy et al* teach the device of claim 36 as applied above, yet fail to teach the electronic mail receiving/reproducing device of claim 36, further comprising a real data search means which, based on IDs and corresponding real data stored in categorized manner, searches for data belonging to a higher order category of a received ID or representative data if

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there is no real data corresponding to the received ID. However, *Luzeski et al* teach the method of searching for attachments/real data, based on the stored and corresponding categorized IDs and data (Abstract, col.11 lines 41-53 and col.12 line 57-col.13 line 20).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Rudy et al*, *Guck* and *Luzeski et al* to permit real data search means for the purpose of retrieving the attached data for the client/user. One skilled in the art would have been motivated to generate the claimed invention with a reasonable expectation of success

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: *Scheussler et al* (USPN 6,366,950), *Miller et al* (USPN 6,421,707), *Tsai* (USPN 6,839,741), *Mertama et al* (USPN 6,629,130), *Barrett et al* (USPN 6,549,933) and *Brodersen et al* (USPN 6,732,111).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds


RUPAL DHARIA
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